

REMARKS

Applicants' undersigned attorney thanks the Examiner for her comments. Applicants respectfully request reconsideration of this patent application, particularly in view of the following remarks. Currently, Claims 1-57 and 59 are pending, and *Claim 58 has been canceled.*

Claim Rejections - 35 U.S.C. §112

The rejection of Claims 1-57 (Claim 58 has been canceled) under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is respectfully traversed.

On page 2 of the Office Action, the Examiner states that Independent Claims 1, 15, 19, 36 and 52 recite that the fastening components being in the unfastened condition. Claims 1, 15 and 19 recite "the fastening component and the mating fastening component being in the unfastened condition." Claims 36 and 52 recite "the mechanical fastening element and the attachment surface being in the unfastened condition." The Examiner states "it is unclear to the examiner when the garment is in an unfastened condition. Does the garment remain in the unfastened condition? If so, this contradicts the 'mating' language, which denotes that at some point the item has to be fastened. It is unclear whether the item is never fastened."

Under 35 U.S.C. §112, second paragraph, the test for definiteness entails "a determination of whether those skilled in the art would understand what is claimed when the claim is read in light of the specification." Orthokinetics, Inc. vs. Safety Travel Chairs, Inc., 1 USPQ2d, 1081, 1088 (Fed. Cir. 1986); MPEP 2173.02.

The Specification makes clear that the passive side bonds are in place to hold the front side panels and the back side panels together without having to engage the fastening component and the mating fastening component during the manufacturing process. Thus, leaving the fastening component and the mating fastening component unfastened, or in the "unfastened condition" was the main feature of the invention.

The Specification on page 2 discusses the manufacturing difficulties involved with engaging the fastening component and the mating fastening component for prefastened garments.

Also, page 3 of the Specification states:

In response to the discussed difficulties, this invention is directed in particular embodiments to a fastenable or refastenable personal care garment, including a low strength frangible bond connecting the front side panels and the back side panels, *for which the fastening system does not need to be prefastened at the time of manufacture. The side panels can, therefore, be manufactured flat against each other and not overlapped for the purpose of engaging the fasteners. The frangible bond can be easily broken by the user prior to use and the fasteners can be engaged prior to, or during, donning.* (Specification, page 3, lines 10-17; Emphasis added)

Furthermore, page 4 of the Specification states:

The consumer first breaks the frangible bonds, then dons the product by first prefastening the fasteners, *or in the alternative the consumer could don the product with the fasteners unfastened and the frangible bond intact.* (Specification, page 4, lines 1-3; Emphasis added)

Also, page 5 of the Specification states:

With the foregoing in mind, it is a feature and advantage of the invention to provide a fastenable or refastenable garment *that does not require that the fastening system be prefastened at the time of manufacture.* (Specification, page 5, lines 14-16; Emphasis added)

The Figures together with the text of the Specification specify particularly what “in the unfastened condition” means. It is also clear the frangible bonds are intact only when the fastening component and mating fastening components are in the unfastened condition, and that the fasteners can only be engaged by breaking the frangible bonds. Referring to Figure 1A, page 38 of the Specification states:

The fastening components 82 and the mating fastening components 84 are in the *unfastened condition*, and are

engageable only upon breaking the frangible bonds 100. As mentioned previously, the consumer has the option of first breaking the frangible bonds 100, then donning the training pant 20 by first prefastening the fastening components 82 and mating fastening components 84, *or in the alternative* the consumer could don the product with frangible bonds 100 intact *and the fastening components 82 and mating fastening components 84 unfastened*. (Specification, page 38, lines 8-15; Emphasis added)

Also, the Specification on page 40, lines 7-9, provides:

Alternatively, the consumer can keep the frangible bonds 100 intact and don the product *without fastening the fastening components 82 and mating fastening components 84*.

The Examiner stated that it was unclear when the garment is in an unfastened condition. The claims and the Specification, however, address the fastening component and the mating fastening component being in the unfastened condition, not the garment.

Therefore, reviewing the claims in light of the specification, Applicants assert that one skilled in the art would understand what the fastening components “in the unfastened condition” means. Thus, Applicants respectfully request withdrawal of this rejection.

Claim Rejections - 35 U.S.C. §102

The rejection of Claims 1-4, 8-21, 29-43, 46-48 and 52-57 (Claim 58 has been canceled) under 35 U.S.C. §102 as being anticipated by Elsberg (U.S. Patent No. 6,287,287) is respectfully traversed. Applicants note that on pages 2-3 of the Office Action, the Examiner identified §102(a) in paragraph 4, but §102(b) in paragraph 5. Applicants assume the rejection is under §102(a).

Applicants note that the 35 U.S.C. §102 rejection is the same as that set forth in the previous 04 May 2004 Office Action.

Elsberg discloses a prefastened disposable absorbent article including a pair of passive side bonds that help to maintain the absorbent article in a prefastened condition. (Col. 2, lines 40-46).

For a reference to anticipate a claim, the reference must disclose each and every element or limitation of the claim. Elsberg does not disclose each and every element or limitation of Applicants' claims, as amended.

With respect to Claim 1, the Examiner states on page 3 of the Office Action that the fastening component and the mating fastening component disclosed in Elsberg are in the unfastened condition and cites Col. 2, lines 27-46. Applicants respectfully disagree that this passage from Elsberg, or any other section thereof, discloses that the fastening component and the mating fastening component are in the unfastened condition.

Col. 2, lines 27-46 of Elsberg provide:

In response to the difficulties and problems discussed above, a new prefastened disposable absorbent article which has passive side bonds and an adjustable fastening system has been discovered. In one aspect, the present invention concerns a prefastened disposable absorbent article which defines an absorbent, a front waist region, a back waist region, a crotch region which extends between and connects the waist regions and a pair of opposed side edges. The prefastened absorbent article includes a pair of primary fasteners which are located on the opposed side edges in one of the waist regions. The primary fasteners overlap and releasably engage the opposite waist region of the absorbent article to provide the prefastened absorbent article. The article further includes a pair of passive side bonds which are located inward of the primary fasteners. *The passive side bonds releasably connect an overlapped portion of the one waist region to the opposite waist region to assist in maintaining the prefastened absorbent article in a prefastened condition.* (Emphasis added). (Col. 2, lines 27-46).

Therefore, Col. 2, lines 27-46 of Elsberg does not disclose that the fastening component and the mating fastening component are in the unfastened condition. Rather, the article is in a prefastened condition. Similarly, the remainder of Elsberg does

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not disclose that the fastening component and the mating fastening component are in the unfastened condition when the passive side bonds are in place.

The fastening system of Elsberg includes a pair of primary fasteners 62, a pair of secondary fasteners 64, a pair of passive side bonds 80 and 82 and an attachment panel 66. (Col. 5, lines 14-18; Col. 10, line 63 to Col. 17, line 61).

Elsberg discloses that “prefastened” means that the fasteners are releasably engaged. “In the different aspect of the present invention, the primary fasteners 62 are releasably engaged with the outer surface of the opposite waist region 22 and 24 of the diaper 20 before the diaper 20 is placed on the wearer to provide a prefastened diaper.” (Col. 11, lines 45-49; Emphasis added).

As previously stated, the passive side bonds of Elsberg assist in maintaining the absorbent article in a prefastened condition. Elsberg states:

The prefastened absorbent article of the different aspects of the present invention further includes a pair of passive side bonds for improved reliability of *maintaining the article in a prefastened condition* particularly when it is being pulled on over the hips of the wearer. ... In such a configuration, the passive side bonds 80 and 82 assist the fastening system 60 in *maintaining the diaper in a prefastened condition* as the diaper 20 is pulled up or down over the hips of the wearer. (Col. 15, lines 6-25; Emphasis added).

Since the passive side bonds of Elsberg assist the fastening system in maintaining the absorbent article in a prefastened condition, the fasteners are engaged or fastened. Therefore, the fastening component and the mating fastening component are not in the unfastened condition and this rejection should be withdrawn.

With respect to Claim 15, on page 4-5 of the Office Action, the Examiner states that the limitation regarding the fastening component and the mating fastening component being engageable only upon breaking the frangible bond is directed to an intended use of the article and that intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. The Examiner further states that the invention of Elsberg meets the structural limitations of the claim. Applicants respectfully disagree

that Elsberg meets the structural limitations of Claim 15. The Examiner states that the fastening component and the mating fastening component disclosed in Elsberg are in the unfastened condition and cites Col. 2, lines 27-46. This is the exact same passage cited by the Examiner for the same structural limitation recited in Claim 1. For all of the same reasons stated above in the discussion of Claim 1, Applicants respectfully disagree that Elsberg discloses that the fastening component and the mating fastening component are in the unfastened condition. The Examiner also cited Figure 4 of Elsberg for support of the limitation of the fastening component and the mating fastening component being in the unfastened condition. Again, Applicants respectfully disagree. Figure 4 of Elsberg shows "a plan view of the disposable absorbent article of FIG. 1 in an unfastened, stretched and laid flat condition." (Col. 4, lines 18-20). Figure 4 simply shows where the location of the passive side bonds 80 and 82 will be in the prefastened article.

In Elsberg, the fastening component and the mating fastening component are not in the unfastened condition when the passive side bonds are in place. Therefore, this rejection should be withdrawn with respect to Claims 15-18.

With respect to Claim 19, on pages 5-6 of the Office Action, the Examiner states that Elsberg discloses that the fastening component and mating fastening component are in the unfastened condition and cites Col. 17, line 65 to Col. 18, line 9.

Col. 17, line 65 to Col. 18, line 14 of Elsberg provide:

The fastening system is *prefastened* to releasably engage the front and back waist portions to allow the absorbent article to be pulled up or down over the hips of the wearer such as conventional training pants. Moreover, the fastening system can be used to releasably engage and adjust the front and back waist portions of the absorbent article to maintain the absorbent article about the waist of the wearer after the article has been pulled on in a similar manner to conventional diapers. The passive side bonds assist the fastening system *in maintaining the article in a prefastened condition* as the article is pulled up or down over the hips of the wearer. Moreover, the passive side bonds prevent movement and shifting of the waist portions relative to each other for improved fit and performance. The passive side bonds also prevent the rollover or folding on the side and waist edges of the prefastened absorbent

article as it is pulled over the wearer's hips. (Emphasis added). (Col. 17, line 65 to Col. 18, line 14).

Therefore, Col. 17, line 65 to Col. 18, line 9 of Elsberg does not disclose that the fastening component and the mating fastening component are in the unfastened condition. In addition, as previously discussed, the remainder of Elsberg does not disclose that the fastening component and the mating fastening component are in the unfastened condition. Therefore, this rejection should be withdrawn.

With respect to Claim 36, Claim 36 has been previously amended to recite that the mechanical fastening element and the attachment surface being in the unfastened condition. As stated previously, Elsberg does not disclose that the fasteners are in the unfastened condition when the passive side bonds are in place. Therefore, this rejection should be withdrawn.

With respect to Claim 52, Claim 52 has also been previously amended to recite that the mechanical fastening element and the attachment surface being in the unfastened condition. Again, as stated previously, Elsberg does not disclose that the fasteners are in the unfastened condition when the passive side bonds are in place. Therefore, this rejection should be withdrawn.

Claim 58 has been canceled.

For at least the reasons presented above, Applicants respectfully submit that Claims 1-4, 8-21, 29-43, 46-48 and 52-58 are not anticipated by Elsberg. Thus, Applicants respectfully request withdrawal of this rejection.

Claim Rejections - 35 U.S.C. §103

The rejection of Claims 5-7, 22-28, 44 and 45 under 35 U.S.C. §103(a) as being unpatentable over Elsberg (U.S. Patent No. 6,287,287) is respectfully traversed.

Claims 5-7, 22-28, 44 and 45 depend from Claims 1, 19 and 41. On page 12 of the Office Action, the Examiner states that Elsberg discloses the invention substantially as claimed, but is silent on the width of the frangible bonds and silent on the distance between the fastening components and the distal edges.

Applicants note that the 35 U.S.C. §103 rejections is the same as that set forth in the previous 04 May 2004 Office Action.

Applicants respectfully disagree that Elsberg discloses the invention substantially as claimed.

One of the factors in establishing a prima facie case of obviousness is that the prior art references, when combined, must teach or suggest all the claim limitations. As discussed above with respect to Claims 1, 19 and 41, Elsberg does not disclose all of the limitations of Claims 1, 19 or 41.

For at least the reasons presented above, Applicants respectfully submit that Claims 5-7, 22-28 44 and 45 are not rendered obvious by Elsberg. Thus, Applicants respectfully request withdrawal of this rejection.

Allowable Subject Matter

On page 13 of the Office Action, the Examiner indicated that Claim 59 is allowed, and also that Claims 49-51 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 49 depends from Claim 36, as previously amended. Applicants submit that Claim 49 is still allowable. Claims 50-51 depend from Claim 49. Therefore, these claims should be allowed.

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Conclusion

Applicants intend to be fully responsive to the outstanding Office Action. If the Examiner detects any issue which the Examiner believes Applicants have not addressed in this response, Applicants' undersigned attorney requests a telephone interview with the Examiner.

Respectfully submitted,

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